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PATENT  
Attorney Docket No.: 021737-000500US

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By: \_\_\_\_\_

Tara N. Damhoff



**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re application of:

JEFFRY J. GRAINGER

Application No.: 09/733,616

Filed: December 7, 2000

For: COMPUTER IMPLEMENTED  
METHOD OF GENERATING  
INFORMATION DISCLOSURE  
STATEMENTS

Customer No.: 20350

Confirmation No.: 4192

Examiner: Janice A. Mooneyham

Art Unit: 3629

SUPPLEMENTAL INFORMATION  
DISCLOSURE STATEMENT UNDER 37  
CFR §1.97 and §1.98

**Mail Stop RCE**  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir:

The references cited on attached form PTO/SB/08A and PTO/SB/08B are being called to the attention of the Examiner. Copies of the references are enclosed. It is respectfully requested that the cited references be expressly considered during the prosecution of this application, and the references be made of record therein and appear among the "references cited" on any patent to issue therefrom.

The applicant filed an information disclosure statement on December 11, 2001. The Examiner considered the information disclosure statement on February 25, 2004, but three of the references on the information disclosure statement were not initialed by the Examiner, indicating that the Examiner did not consider those references. A copy of the previously-considered information disclosure statement is submitted herewith, with the unconsidered references highlighted. Additional copies of those references, with a new information disclosure statement, are also submitted herewith. The applicant respectfully requests that the Examiner consider these references.

As provided for by 37 CFR 1.97(g) and (h), no inference should be made that the information and references cited are prior art merely because they are in this statement and no representation is being made that a search has been conducted or that this statement encompasses all the possible relevant information.

Applicant believes that no fee is required for submission of this statement. However, if a fee is required, the Commissioner is authorized to deduct such fee from the undersigned's Deposit Account No. 20-1430. Please deduct any additional fees from, or credit any overpayment to, the above-noted Deposit Account.

Respectfully submitted,

  
Chad E. King  
Reg. No. 44,187

TOWNSEND and TOWNSEND and CREW LLP  
Two Embarcadero Center, Eighth Floor  
San Francisco, California 94111-3834  
Tel: 303-571-4000  
Fax: 303-571-4321  
CEK:tnd  
60430063 v1

Substitute for form 1449A/PTO

**INFORMATION DISCLOSURE  
STATEMENT BY APPLICANT**

(use as many sheets as necessary)

Sheet

1

of

**Complete if Known**

Application Number	09/733,616
Filing Date	December 7, 2000
First Named Inventor	Grainger, Jeffrey J.
Art Unit	3629
Examiner Name	Janice A. Mooneyham
Attorney Docket Number	021737-000500US

**U.S. PATENT DOCUMENTS+**

Examiner Initials*	Cite No. <sup>1</sup>	Document Number Number Kind Code <sup>2</sup> (if known)	Publication Date MM-DD-YYYY	Name of Patentee or Applicant of Cited Document	Pages, Columns, Lines, Where Relevant Passages or Relevant Figures Appear
	A1	US-5,781,901	07-14-1998	Kuzma	
	A2	US-			
	A3	US-			
	A4	US-			

**FOREIGN PATENT DOCUMENTS**

Examiner Initials*	Cite No. <sup>1</sup>	Foreign Patent Document			Publication Date MM-DD-YYYY	Name of Patentee or Applicant of Cited Document	Pages, Columns, Lines, Where Relevant Passages or Relevant Figures Appear	T <sup>6</sup>
		Country Code <sup>3</sup>	Number <sup>4</sup>	Kind Code <sup>5</sup> (if known)				
	B1	WO	01/08031	A2	02-01-2001	Morris et al.		<input type="checkbox"/>
	B2							<input type="checkbox"/>
	B3							<input type="checkbox"/>
	A4							<input type="checkbox"/>

Examiner  
SignatureDate  
Considered

\*EXAMINER: Initial if reference considered, whether or not citation is in conformance with MPEP 609. Draw line through citation if not in conformance and not considered. Include copy of this form with next communication to applicant. <sup>1</sup> Applicant's unique citation designation number (optional). <sup>2</sup> Kind Codes of U.S. Patent Documents at [www.uspto.gov](http://www.uspto.gov) or MPEP 901.04. <sup>3</sup> Enter Office that issued the document, by the two-letter code (WIPO Standard ST.3). <sup>4</sup> For Japanese patent documents, the indication of the year of the reign of the Emperor must precede the serial number of the patent document. <sup>5</sup> Kind of document by the appropriate symbols as indicated on the document under WIPO Standard ST. 16 if possible. <sup>6</sup> Applicant is to place a check mark here if English language Translation is attached.

60430063 v1

Substitute for form 1449B/PTO  <b>INFORMATION DISCLOSURE STATEMENT BY APPLICANT</b>  <i>(use as many sheets as necessary)</i>			<b>Complete if Known</b>		
			Application Number	09/733,616	
			Filing Date	December 7, 2000	
			First Named Inventor	Grainger, Jeffry J.	
			Art Unit	3629	
			Examiner Name	Janice A. Mooneyham	
Sheet	2	of		Attorney Docket Number	021737-000500US

NON PATENT LITERATURE DOCUMENTS			
Examiner Initials *	Cite No. <sup>1</sup>	Include name of the author (in CAPITAL LETTERS), title of the article (when appropriate), title of the item (book, magazine, journal, serial, symposium, catalog, etc.), date, page(s), volume-issue number(s), publisher, city and/or country where published.	T <sup>2</sup>
	A1	IPSearchEngine.com. Retrieved from the Internet: <URL:http://www.ipsearchengine.com/index.asp?> 32 pages total.	
	C2		
	C3		
	C4		

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<sup>1</sup> Applicant's unique citation designation number (optional). <sup>2</sup> Applicant is to place a check mark here if English language Translation is attached.

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Attorney Docket No.: 020313-000500US

Assistant Commissioner for Patents  
Washington, D.C. 20231

On 12/11/01

TOWNSEND and TOWNSEND and CREW LLP

By: [Signature]  
Signature Vinh Vu

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

**Received**  
DEC 11 2001  
Technology Center 2100

In re application of:

JEFFRY J. GRAINGER

Application No.: 09/733,616

Filed: December 7, 2000

For: COMPUTER IMPLEMENTED  
METHOD OF GENERATING  
INFORMATION DISCLOSURE  
STATEMENTS

Examiner: Unassigned

Art Unit: 2163

INFORMATION DISCLOSURE  
STATEMENT UNDER 37 CFR §1.97 and  
§1.98

Assistant Commissioner for Patents  
Washington, D.C. 20231

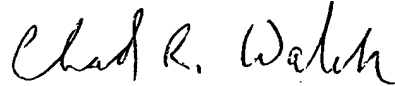
Sir:

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Applicant believes that no fee is required for submission of this statement, since it is being submitted prior to the first Office Action. However, if a fee is required, the Commissioner is authorized to deduct such fee from the undersigned's Deposit Account No. 20-1430. Please deduct any additional fees from, or credit any overpayment to, the above-noted Deposit Account.

Respectfully submitted,



Chad R. Walsh  
Reg. No. 43,235

TOWNSEND and TOWNSEND and CREW LLP  
Two Embarcadero Center, 8<sup>th</sup> Floor  
San Francisco, California 94111-3834  
Tel: 650-326-2400  
Fax: 650-326-2422  
CRW:km

Substitute for form 1449B/PTO		<b>Complete if Known</b>	
<b>INFORMATION DISCLOSURE STATEMENT BY APPLICANT</b>  (use as many sheets as necessary)		Application Number	09/733,616
		Filing Date	December 7, 2000
		First Named Inventor	Grainger, Jeffry J.
		Group Art Unit	2163
		Examiner Name	To Be Assigned
Sheet <b>3</b>	of	Attorney Docket Number	020313-000500US

U.S. PATENT DOCUMENTS						
Examiner Initials *	Cite No. <sup>1</sup>	U.S. Patent Document		Name of Patentee or Applicant of Cited Document	Date of Publication of Cited Document MM-DD-YYYY	Pages, Columns, Lines, Where Relevant Passages or Relevant Figures Appear
		Number	Kind Code <sup>2</sup> (if known)			
GROUP 3600	1	5,247,661		Hager et al.	09-21-1993	
	2	5,276,869		Forrest et al.	01-04-1994	
	3	5,317,683		Hager et al.	05-31-1994	
	4	5,377,355		Hager et al.	12-27-1994	
	5	5,418,908		Keller et al.	05-23-1995	
	6	5,446,880		Balgeman et al.	08-29-1995	
	7	5,553,289		Johnson et al.	09-03-1996	
	8	5,619,555		Fenton et al.	04-08-1997	
	9	5,628,004		Gormley et al.	05-06-1997	
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	13	5,764,898		Tsuji et al.	06-19-1998	
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	31	6,064,976		Tolopka	05-16-2000	

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Examiner Signature		Date Considered	2/25/04
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PA 3179630 v1

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**INFORMATION DISCLOSURE  
STATEMENT BY APPLICANT**

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Sheet

4

of

**Complete if Known**

Application Number	09/733,616
Filing Date	December 7, 2000
First Named Inventor	Grainger, Jeffry J.
Group Art Unit	2163
Examiner Name	To Be Assigned
Attorney Docket Number	020313-000500US

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**FOREIGN PATENT DOCUMENTS**

Examiner Initials*	Cite No. <sup>1</sup>	Foreign Patent Document			Name of Patentee or Applicant of Cited Document	Date of Publication of Cited Document MM-DD-YYYY	Pages, Columns, Lines Where Relevant Passages or Relevant Figures Appear
		Office <sup>3</sup>	Number <sup>4</sup>	Kind Code <sup>5</sup> (if known)			
	1.	WO	01/08031	A2	Morris et al.	02-01-2001	

**OTHER PRIOR ART -- NON PATENT LITERATURE DOCUMENTS**

Examiner Initials*	Cite No. <sup>1</sup>	Include name of the author (in CAPITAL LETTERS), title of the article (when appropriate), title of the item (book, magazine, journal, serial, symposium, catalog, etc.), date, page(s), volume-issue number(s), publisher, city and/or country where published.
A	32	Computer Patent Annuities, "Welcome to CPA" [retrieved on 2001-09-11]. Retrieved from the Internet: <URL: <a href="http://www.cpajersey.com/cpajersey/maincombo.htm">http://www.cpajersey.com/cpajersey/maincombo.htm</a> > 1 page total.
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Date

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Sheet

5

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Attorney Docket Number	020313-000500US

**OTHER PRIOR ART - NON PATENT LITERATURE DOCUMENTS**

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A	43	CPI Computer Packages Inc., [retrieved on 2001-09-11]. Retrieved from the Internet: <URL: <a href="http://www.computerpackages.com/">http://www.computerpackages.com/</a> > 1 page total.	
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A	46	EFS Electronic Filing System "Submission Manual ePAVE" United States Patent and Trademark Office [retrieved on 2001-09-11]. Retrieved from the Internet: <URL: <a href="http://www.uspto.gov/">http://www.uspto.gov/</a> > 157 pages total.	
A	47	Intuit Press Release: "E-Filing Completely Paperless With Quicken TurboTax Now Even Easier To Get A Tax Refund Fast" [retrieved on 2001-07-11]. Retrieved from the Internet: <URL: <a href="http://www.intuit.com/company/press_releases/2001/01-12c.html">http://www.intuit.com/company/press_releases/2001/01-12c.html</a> > 2 pages total.	
A	48	Intuit "Electronic Filing software with ProSeries/1040 and individual states" [retrieved on 2001-07-11]. Retrieved from the Internet: <URL: <a href="http://www.proseries.com/efiling/index.shtml">http://www.proseries.com/efiling/index.shtml</a> > 2 pages total.	
A	49	Intuit "TurboTax Premier for Tax Year 2001" [retrieved on 2001-07-11]. Retrieved from the Internet: <URL: <a href="http://www.shopintuit.com/qstore/ProdInfo.asp?BaseCode=TTPRW2001&amp;">http://www.shopintuit.com/qstore/ProdInfo.asp?BaseCode=TTPRW2001&amp;</a> > 6 pages total.	
A	50	LegalStar® Product Solicitation/Brochure entitled "IP Legal Dock Pro Document Management Software for IP Law" ©1999, LegalStar®, P.O. Box 415, Williamsville, NY 14231-0415, 5 pages total	
	51	IPSearchEngine.com [retrieved on 2001-10-11]. Retrieved from the Internet: <URL: <a href="http://www.ipsearchengine.com/index.asp?">http://www.ipsearchengine.com/index.asp?</a> > 17 pages total.	
A	52	IRS "Electronic Services" [retrieved on 2001-07-11]. Retrieved from the Internet: <URL: <a href="http://www.irs.gov/plain/elect_svs/index.html">http://www.irs.gov/plain/elect_svs/index.html</a> > 2 pages total.	
A	53	IRS "Electronic Services IRS e-file for Individual Taxpayers" [retrieved on 2001-07-11]. Retrieved from the Internet: <URL: <a href="http://www.irs.gov/plain/elect_svs/efile-ind.html">http://www.irs.gov/plain/elect_svs/efile-ind.html</a> > 2 pages total.	
A	54	IRS "Electronic Services IRS e-file for IBusinesses" [retrieved on 2001-07-11]. Retrieved from the Internet: <URL: <a href="http://www.irs.gov/plain/elect_svs/efile-bus.html">http://www.irs.gov/plain/elect_svs/efile-bus.html</a> > 2 pages total.	
A	55	IRS "Electronic Services Approved IRS e-file for IBusiness Providers" [retrieved on 2001-07-11]. Retrieved from the Internet: <URL: <a href="http://www.irs.gov/plain/elect_svs/efile-abp.html">http://www.irs.gov/plain/elect_svs/efile-abp.html</a> > 3 pages total.	
A	56	PatentWizard, Inc. [retrieved on 2001-24-10]. Retrieved from the Internet: <URL: <a href="http://www.patentwizard.com/">http://www.patentwizard.com/</a> > 3 pages total.	
A	57	PatentWizard Inc. "About PatentWizard" [retrieved on 2001-24-10]. Retrieved from the Internet: <URL: <a href="http://www.patentwizard.com/htmls/about.htm">http://www.patentwizard.com/htmls/about.htm</a> > 6 pages total.	
A	58	PCT Easy "FAQ" [retrieved on 2001-05-11]. Retrieved from the Internet: <URL: <a href="http://pcteasy.wipo.int/en/help/faq.htm">http://pcteasy.wipo.int/en/help/faq.htm</a> > 7 pages total.	

Examiner  
Signature

Jim Mac

Date  
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**INFORMATION DISCLOSURE  
STATEMENT BY APPLICANT**

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Sheet 6

of

**Complete if Known**

Application Number	09/733,616
Filing Date	December 7, 2000
First Named Inventor	Grainger, Jeffry J.
Group Art Unit	2163
Examiner Name	To Be Assigned
Attorney Docket Number	020313-000500US

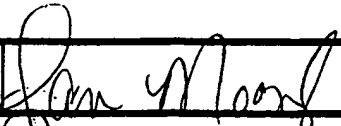
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**OTHER PRIOR ART - NON PATENT LITERATURE DOCUMENTS**

Examiner Initials *	Cite No. <sup>1</sup>	Include name of the author (in CAPITAL LETTERS), title of the article (when appropriate), title of the item (book, magazine, journal, serial, symposium, catalog, etc.), date, page(s), volume-issue number(s), publisher, city and/or country where published.	† <sup>2</sup>
2	59	PerfectLaw Software "About the Company" [retrieved on 2001-05-11]. Retrieved from the Internet: <URL: http://www.perfectlaw.com/aboutthe.htm> 2 pages total.	
2	60	PerfectLaw Software "DocPro" [retrieved on 2001-05-11]. Retrieved from the Internet: <URL: http://www.perfectlaw.com/docpro.htm> 8 pages total.	
2	61	PerfectLaw Software "Front Office Software" [retrieved on 2001-05-11]. Retrieved from the Internet: <URL: http://www.perfectlaw.com/frontoff.htm> 2 pages total.	
2	62	PerfectLaw Software "Back Office Software" [retrieved on 2001-05-11]. Retrieved from the Internet: <URL: http://www.perfectlaw.com/Backoff.htm> 1 pages total.	
2	63	PerfectLaw Software "Case & Matter Management Docket Scheduling" [retrieved on 2001-05-11]. Retrieved from the Internet: <URL: http://www.perfectlaw.com/docketsch> 2 pages total.	
2	64	PerfectLaw Software "Case & Matter Management Documents Processing" [retrieved on 2001-05-11]. Retrieved from the Internet: <URL: http://www.perfectlaw.com/docprocessing.htm> 1 page total.	
2	65	PerfectLaw Software "Case & Matter Management Custom Information Fields" [retrieved on 2001-05-11]. Retrieved from the Internet: <URL: http://www.perfectlaw.com/customtabs.htm> 1 page total.	
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2	69	"Legal Automation News" Issue 19.1, Executive Data Systems, Inc., 2100 Ponce de Leon Blvd., Suite 1200, Coral Gables, FL 33134, pp. 1-4.	

Examiner  
Signature

Date  
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\* EXAMINER: Initial if reference considered, whether or not citation is in conformance with MPEP 609. Draw line through citation if not in conformance and not considered. Include copy of this form with next communication to applicant.

<sup>1</sup> Unique citation designation number. <sup>2</sup> Applicant is to place a check mark here if English language Translation is attached.

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